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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,997	10/26/2005	Kim Stanley Jensen	55320.000801	2842

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EXAMINER
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LEE, LAURA MICHELLE

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/523,997

Applicant(s)

JENSEN ET AL.

Examiner

Laura M. Brean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 11/20/2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see page 10, third paragraph, filed 11/20/2006, with respect to the rejection(s) of claim(s) 1 and 22 under Bergman (WO 86/07017) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bergman (WO 86/07017).

### ***Drawings***

2. The drawings were received on 11/20/2006. These drawings are acceptable.

### ***Specification***

3. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because each sentence is a fragment. Correction is required. See MPEP § 608.01(b).

7. The use of the trademark Velcro has been noted in this application. The entire word should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

8. Claim 18 objected to because of the following informalities:

In claim 18, line 2, there is a lack of proper antecedent fit the limitation, "the motor".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Bergman discloses a tool guiding apparatus for guiding a tool (cutting portion of cutting wire, 3; herein referred to as 3b) along a path (defined by the glue joint) on a surface (windscreen) to be processed, said apparatus comprising: at least one path-defining means (guide member, 7) adapted to be attached to the surface, automatic tool actuation means (motor, page 7, lines 26-29) adapted to advance the tool (cutting section of the cutting wire, 3; herein referred to as 3a) along the path, wherein the automatic tool actuation means comprises a flexible force-transferring element (small segment of cutting wire, 3, near spool 11) comprising a first end and a second end, the

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first end being attached to the automatic tool actuation means (motor) and the second end being attached to the tool (5).

In regards to claim 2, Bergman discloses wherein the path-defining means (7) is adapted to engage at least a part of the flexible force-transferring element (3a) (Figure 1).

In regards to claim 3, Bergman discloses the path-defining means comprises a wheel (spool, 11) adapted to engage at least a part of the force-transferring element (3a).

In regards to claim 4, Bergman discloses wherein the automatic tool actuation means is adapted to be attached to the surface (suction cups, 19)(Figure 1).

In regards to claim 5, Bergman discloses wherein at least one of the automatic tool actuation and the at least one path defining means (7) comprises at least one vacuum cup (19).

In regards to claim 8, Bergman discloses wherein the vacuum cup (19) and the wheel (11) are interconnected by a moment arm (anchorage, 17).

In regards to claim 9, Bergman discloses wherein the radius of the wheel (8) is substantially equal to the radius of a windscreen of an automobile (Figure 1).

In regards to claim 10, Bergman discloses wherein the wheel (8) is capable of being releasably attached to the path defining means (7).

In regards to claim 11, Bergman discloses a plurality of interchangeable wheels (spool, 11, with gear rim 15, and small gear wheel, 16) at least two wheels having different radii (page 7, lines 21-25; Figure 1).

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In regards to claim 12, Bergman discloses wherein at least a path of the surface of the wheel (11) comprises a friction increasing material (page 7, lines 13-15).

In regards to claim 14, Bergman discloses wherein the automatic tool actuation means comprises a motor (motor, page 7, lines 26-29).

In regards to claim 15, Bergman discloses wherein the motor is electrical (page 7, lines 26-29).

In regards to claim 16, Bergman discloses wherein the automatic tool actuation means are adapted to pull the tool (3b) along the path.

In regards to claim 22, Bergman discloses a method for guiding a tool (cutting portion of wire, 3b) along a path (defined by the guide member, 7 and the window pane) on a surface to be processed, said method comprising the steps of: attaching at least one path defining means (guide member, 7) along the path by activating an automatic tool actuation means, (motor, page 7, lines 26-29).

In regards to claim 23, Bergman discloses the step of attaching the automatic tool actuation means to the surface (via suction cups, 19).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6, 7, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman in view of Lawhon (U.S. Patent 4,819,531). Bergman discloses the claimed invention except that the tool, (the cutting edge of the wire), is a knife with a cutting edge. The Bergman device utilizes a ratchet or alternatively a motorized system to advance cutting wire through a glue joint to separate a glued vehicle screen from a vehicle chassis. Attention is further directed to the Lawhon device, which similarly discloses a window panel removal device that utilizes a knife attached to a winch and wire assembly to remove a glued vehicle screen from a vehicle chassis. In the preferable operation, the Lawhon device operator grasps the handle section (25) with one hand and manipulates the winch lever handle (52) with their other hand. Moving the winch lever (49) in a clockwise direction retracts the cable and advances the tool (column, 5, lines 34-51). In both systems the cutting mechanism is being advanced by a winch/ratchet system or alternatively a motorized element, however, in the Lawhon device the operator has greater control of the cutting mechanism. It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the cutting apparatus of Bergman to have incorporated a knife as taught by Lawhon as the knife structure allows for a handle in which it is easier for the operator to guide the cutting device.

In regards to claim 7, Bergman as modified by Lawhon, discloses wherein at least a part of the cutting edge (16; Figure 2) extends in a direction transverse to a line defined by a least a part of the force-transferring element (3). As shown by Figure 1,



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Bergman discloses that the force-transferring element (3) extends both along the horizontal and vertical plane of the windowpane.

In regards to claim 17, Bergman as modified by Lawhon, discloses wherein the knife (blade, 16) is releasably attached (screws, 87) to a fixture (mounting plate, 86).

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman in view of Hall (U.S. Patent 3,886,926). Bergman discloses the claimed invention except that the force-transferring element comprises a friction increasing material. However, attention is directed to the Hall device that discloses an abrasive cutting wire. The abrasive on the wire increases the friction between the cutting elements such that the cutting wire removes more material with each stroke and is therefore more efficient. It would have been obvious to one having ordinary skill in the art to have modified the force transferring element to have an abrasive surface as taught by Hall in order to increase the wire's cutting efficiency.

14. Claims 18-19 and 21 are rejected under 35 U.S.C. 103(a) as obvious over Bergman in view of Lawhon and in further view of Morford et al (U.S. Patent 4,215,475), herein referred to as Morford. Bergman discloses the claimed invention except that and is silent to as whether the motor comprises a means for activating the motor. However, attention is directed to Morford, who discloses a motor for an oscillating cut-out tool for use in removal of a window. Morford discloses a switch (26) for turning on and off the motor. It would have been obvious to one having ordinary skill in the art at the time of

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the invention to have provided a means for activating the motor of Bergman (if not already present) as taught by Morford in order to turn the motor on and off.

In regards to claim 19, Bergman as modified by Lawhon and Morford, discloses wherein the means for activating the motor is adapted to control the speed of the motor. (When the motor is off, the speed velocity is zero, when the motor is turned on; the motor speed increases to a predetermined velocity).

In regards to claim 21, Bergman as modified by Morford, discloses wherein the means for activating the motor is adapted to control the speed of the motor. (When the motor is off, the speed velocity is zero, when the motor is turned on; the motor speed increases to a predetermined velocity).

15. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman in view of Lawhon and Morford and in further view of Patton (U.S. Publication 2003/0188441). Bergman discloses the claimed invention except that wherein the means for activating the motor is wireless. Attention is further directed to the Patton device that discloses a router with a wireless control device. The wireless device allows the switch to be located in a more ergonomical position for the user as the location is not dependent upon the routing of the electrical wire. It similarly would have been obvious to have modified the motor activating means of Bergman so that the switch could be located at a more convenient location for the user as taught by Patton.

### ***Conclusion***

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura M. Brean whose telephone number is (571) 272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LMB  
12/14/2006



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